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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/980,687	08/21/2002	Eric Haffner	0249-0123P	8604
2292	7590	12/19/2003	EXAMINER	
BIRCH STEWART KOLASCH & BIRCH			ALVO, MARC S	
PO BOX 747			ART UNIT	
FALLS CHURCH, VA 22040-0747			PAPER NUMBER	

1731

DATE MAILED: 12/19/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/980,687	HAFFNER	
	Examiner	Art Unit	
	Steve Alvo	1731	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 30-51 is/are pending in the application.
- 4a) Of the above claim(s) 30 is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 31-51 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 5) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 6) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) <u>12-764</u> | Other: _____ |

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The arguments with respect to the restriction requirement have been considered, but are not convincing as the inventions listed as Groups I and II do not relate to a single general concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical features for the following reasons:

Claim 2 is obvious over U.S. Patent DE 29 24 794. Accordingly, the special feature linking the two inventions, the use of a pulper to separate solid particles (pulp fibers) from liquid (water) in a pulp suspension, does not provide a contribution over the prior art, and no single general inventive concept exists. The fact that claim 32 depends from claim 31 does not change the fact that the "special feature" linking the two inventions is obvious over DE 29 24 794. Therefore, restriction is appropriate.

Claims 32-51 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 32-51 are drawn to apparatus, which is a different statutory class than claim 31, which is drawn to a method. The method steps of claim 31 can not be given probative weight in an apparatus claim. Apparatus claims 32-51 are vague, indefinite and improper as they depend on a method claim. The combination makes the claims unclear as to whether they are method claims or apparatus claims.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 31-43, 50 and 51 are rejected under 35 U.S.C. 103(a) as being unpatentable over EP 29 24 794 in view of CHRIST et al (5,257,698) and AMAND (4,443,331) or SERRES et al (5,131,544) or ESNOR et al (4,533,468).

EP 29 24 794 teaches a pulping apparatus wherein inlet pipe (6) bring the fibrous suspension to the center of body (1) to blades (7) which break up the fibers and send them to grate (3) which retains part of the fibrous suspension while the water and small particles pass through the grate (6) concentrating the remainder of the suspension which passes along the grate and out of the body (1). CHRIST et al teaches a pulping apparatus wherein pulp fibers are pulped (disintegrated, column 7, lines 31-36) similar to the pulping apparatus of EP 29 24 794, wherein a fibrous material passes into the center of the body to blades (13) and the liquid and small p[articles are separated from the liquid through openings into light particles (28). CHRIST et al teaches further subjecting the fibrous suspension to blades (37) and further separates out the and heavy particles (50). It would have been obvious to further separate the fine particles from the heavy particles of EP 29 24 794 using the separator of CHRIST et al. AMAND or SERRES et al or ESNOR et al further teach removing particles from fibrous suspensions it would have been obvious to the routineer to further clarify the suspension of EP 29 24 794 using the clarifier of AMAND or SERRES et al or ESNOR et al . See also clarifier (100) of CHRIST et al. It is noted that the process steps are not given probative weight in an apparatus claim.

Claims 44-49 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

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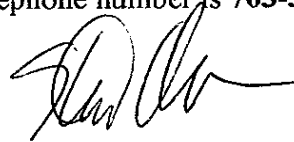
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When filing an **"Official"** FAX in Group 1730, please indicate in the Header (upper right) **"Official"** for papers that are to be entered into the file. The **"Official"** FAX phone number for this TC 1700 is: 703-872-9306.

Any inquiry concerning this communication or earlier communications from the **primary examiner** should be directed to **Steve Alvo** whose telephone number is **(703) 308-2048**. The Examiner can normally be reached on Monday - Friday from **6:00 AM - 2:30 PM (EST)**.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. Steve Griffin, can be reached on 703-308-1164.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the **Group receptionist** whose telephone number is **703-308-0661**.



STEVE ALVO
PRIMARY EXAMINER
ART UNIT 1731

MSA
December 14, 2003